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The applicant hereby requests that the examiner withdraw the finality of the final rejection based on the following points. The applicant notes that the examiner has issued a final action. The applicant notes further that in the final action the examiner has introduced a new ground for rejection. Specifically, in the final action the examiner has introduced a new rejection of claim 1 under 35 U.S.C. 112, as discussed below. The rejection of claim 1 made by the examiner under 35 U.S.C. 112 is a new ground for rejection because this specific ground for rejection has not been made in a previous office action. The applicant notes still further that this new ground for rejection is neither necessitated by applicant's amendments to the claims, nor based on information submitted in an information disclosure statement.

The applicant notes that “second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement” (MPEP 706.07(a).)

Accordingly, the applicant contends that the finality of the final rejection is premature and should therefore be withdrawn in order to give the applicant an opportunity to respond to the new grounds of rejection as provided by the applicable rules.

There are no amendments to the claims.

Claim 1 has been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The examiner states that “in particular, claim 1, what contains the self-propelled light bar assembly, is not defined what applicant intended to claim.” (Office action, page 2, paragraph 2.)

The applicant is unsure of the exact meaning of the examiner's statement, and is therefore unable to determine exactly why the examiner contends that claim 1 does not meet the standards of 35 U.S.C. 112, second paragraph.

1 Nevertheless, the applicant notes that there are two separate requirements
2 set forth in 35 U.S.C. 112, second paragraph. (MPEP 2171.) The first requirement
3 is that the claims must set forth the subject matter that the applicant regards as the
4 invention, and the second requirement is that the claims must particularly point out
5 and distinctly define the metes and bounds of the subject matter that will be
6 protected by the patent grant. (Id.)

7 A rejection based on the first requirement is appropriate only where the
8 applicant has stated, somewhere other than in the application as filed, that the
9 invention is something different from what is defined by the claims. (Id.) In other
10 words, the invention set forth in the claims must be presumed, in the absence of
11 evidence to the contrary, to be that which the applicant regards as the
12 invention. (Id.)

13 The standard for rejection of a claim based on the second requirement is
14 appropriate only where one of ordinary skill in the art would not understand what is
15 claimed in light of the specification. (MPEP 2173.05(b).) In other words, if the scope
16 of the invention sought to be patented can be determined from the language of the
17 claims with a reasonable degree of certainty, a rejection of the claims based on the
18 second requirement is not appropriate. (MPEP 2173.02.)

19 Thus, if the scope of the subject matter embraced by the claims is clear, and if
20 the applicant has not otherwise indicated that the invention is intended to be of a
21 scope different from that defined in the claims, then the claims comply with 35 U.S.C.
22 112, second paragraph. (MPEP 2173.04.)

23 The applicant has not otherwise indicated that the invention is intended to be
24 of a scope different from that defined in claim 1, and the scope of the subject matter
25 embraced by claim 1 is abundantly clear, particularly in light of the specification. For
example, in the paragraph at page 9, line 21 through page 10, line 5, the general
meaning of "self-propelled light bar assembly" is provided, and the paragraphs which
follow provide specific examples of a "scanning apparatus having a self-propelled
light bar assembly." The applicant therefore contends that claim 1 complies with the
requirements of 35 U.S.C. 112, second paragraph.

 Accordingly, the applicant respectfully requests that the examiner withdraw
the rejection of claim 1 under 35 U.S.C. 112, second paragraph.

1 Rejection of Claims Under 35 U.S.C. § 102:

2 Claims 1-4, 6, 11, 13, 15-16, 18-25, and 29-32 have been rejected under 35
3 U.S.C. 102(a) as being anticipated by U.S. Patent 4,908,717 to Natori.

4 The applicant notes that claim 1 includes the following limitations:

5 a scanner body; and

6 a self-propelled light bar assembly supported within the scanner body.

7 The examiner contends that Natori teaches an optical scanning apparatus
8 (image scanner of Fig. 2) comprising: a self-propelled light bar assembly (light
9 source unit 10 of Fig. 4, to move parallel along the guide rail means 7 and 8 of
10 Fig. 4) supported within the scanner body (scanner 1 of Fig. 4, col. 5, lines 29-35).

11 The applicant notes that the meaning of the term "self-propelled light bar
12 assembly" would be abundantly clear to anyone of ordinary skill in the art, and
13 particularly so in light of the specification, as discussed above. However, the
14 applicant notes from the examiner's arguments in the Office action that the examiner
15 may be confused with respect to the meaning of the term "self-propelled light bar
16 assembly."

17 Accordingly, the applicant notes that a common definition of the term "self-
18 propelled" is: containing within itself the means for its own propulsion. (Merriam-
19 Webster Online Dictionary, <http://www.m-w.com/dictionary/self%20propelled>.) Thus,
20 the plain meaning of the term "self-propelled light bar assembly" is a light bar
21 assembly containing within itself the means for its own propulsion. This is consistent
22 with the description at paragraph at page 9, line 21 through page 10, line 5, which
23 states (in part):

24 The present invention provides for an optical scanning apparatus
25 having a self-propelled light bar assembly, as will be more full described
below. By "self propelled" I mean that the light bar assembly contains
the drive source (i.e., the motive source which drives the light bar
assembly relative to the scanner body). This is to be distinguished from
the prior art scanner apparatus, wherein the motive source for the light
bar is not supported by, or contained within, the light bar and it's
immediately supporting structure. (Emphasis added.)

1 Natori does not anticipate claim 1 because each and every element as set
2 forth in claim 1 is not found, either expressly or inherently described, in Natori.
3 Specifically, Natori does not disclose a self-propelled light bar assembly, as is
4 required by claim 1.

5 Instead, Natori discloses no more than a light bar assembly (10) that is
6 propelled by way of driving means (25), which is supported on the base frame (3).
7 (Natori, col. 4, line 39 through col. 5, line 45.) That is, the light bar assembly taught
8 by Natori is not self-propelled because the means for propelling the light bar
9 assembly is not contained within the light bar assembly, but is instead supported on
10 a stationary frame external to the light bar assembly.

11 Accordingly, for at least the reasons set forth above, the applicant contends
12 that Natori does not anticipate claim 1, and the applicant therefore respectfully
13 requests that the rejection of claim 1 under 35 U.S.C. 102 be withdrawn.

14 The applicant notes that claims 2-7 and 9-10 depend from claim 1. Therefore,
15 each of claims 2-7 and 9-10 include all of the limitations of claim 1. Accordingly, for
16 at least the reasons set forth above with respect to claim 1, the applicant contends
17 that Natori does not anticipate any of claims 2-7 and 9-10, and the applicant
18 therefore respectfully requests that the rejections of each of claims 2-7 and 9-10
19 under 35 U.S.C. 102 be withdrawn.

20 The applicant notes that claim 11 includes the following limitations:

21 a scanner body;

22 a light bar assembly supported within the scanner body, the light bar assembly
23 comprising a drive motor and a light source, the light bar assembly configured to move
24 the drive motor and the light source together.

25 The examiner contends that Natori teaches a light bar assembly (light source
unit 10 of Fig. 4, to move parallel along the guide rail means 7 and 8 of Fig. 4), the
light bar assembly comprising a drive motor (the drive motor 24 of Fig. 3), and light
source, the light bar assembly configured to move the drive motor and the light
source together.

Natori does not anticipate claim 11 because each and every element as set
forth in claim 11 is not found, either expressly or inherently described, in Natori.

1 Specifically, Natori does not disclose the light bar assembly comprising a drive
2 motor, as is required by claim 11.

3 Instead, as already discussed above, Natori teaches an apparatus having a
4 light bar assembly (10) that is propelled by way of driving means (25), which is
5 supported on the base frame (3). (Natori, col. 4, line 39 through col. 5, line 45.) That
6 is, the light bar assembly taught by Natori does not comprise the drive means, or
7 drive motor. Rather, the drive means of Natori is supported on the stationary base
8 frame (3).

9 Accordingly, for at least the reasons set forth above, the applicant contends
10 that Natori does not anticipate claim 11, and the applicant therefore respectfully
11 requests that the rejection of claim 11 under 35 U.S.C. 102 be withdrawn.

12 The applicant notes that claims 12-15 depend from claim 11. Therefore, each
13 of claims 12-15 include all of the limitations of claim 11. Accordingly, for at least the
14 reasons set forth above with respect to claim 11, the applicant contends that Natori
15 does not anticipate any of claims 12-15, and the applicant therefore respectfully
16 requests that the rejections of each of claims 12-15 under 35 U.S.C. 102
17 be withdrawn.

18 The applicant notes that claim 16 includes the following limitations:

19 a scanner body;

20 a magnet-track portion of a linear electric motor fixedly supported within the
21 scanner body;

22 a light bar assembly comprising a slider portion of a linear electric motor;

23 and

24 wherein the light bar assembly is supported in the scanner body to place the
25 magnet-track portion in proximity to the slider portion to thereby allow the light bar
assembly to be driven along the magnet-track portion.

26 The applicant notes with particularity that the examiner does not even allege
27 in the Office action that Natori discloses "a light bar assembly comprising a slider
28 portion of a linear electric motor" as is required by claim 16. The applicant contends
29 that the examiner's rejection of claim 16 is therefore defective because the examiner
30 does not allege that each and every element as set forth in claim 16 is found, either
31 expressly or inherently described, in Natori.

1 Nevertheless, the applicant contends that even if the examiner had alleged
2 that Natori discloses each and every element set forth in claim 16, as is required for
3 anticipation (which the examiner has not done), Natori does not, in fact, anticipate
4 claim 16 because Natori does not disclose "a light bar assembly comprising a slider
5 portion of a linear electric motor" as is required by claim 16.

6 Instead, as already discussed above, Natori teaches an apparatus having no
7 more than a light bar assembly (10) that is propelled by way of driving means (25),
8 which is supported on the base frame (3). (Natori, col. 4, line 39 through col. 5,
9 line 45.) That is, Natori does not even disclose a linear electric motor, let alone a
10 light bar assembly comprising a slider portion of a linear electric motor. Instead,
11 Natori discloses no more than a standard drive motor that is supported on the
12 stationary base frame (3).

13 Accordingly, for at least the reasons set forth above, the applicant contends
14 that Natori does not anticipate claim 16, and the applicant therefore respectfully
15 requests that the rejection of claim 16 under 35 U.S.C. 102 be withdrawn.

16 The applicant notes that claims 17-22 depend from claim 16. Therefore, each
17 of claims 17-22 include all of the limitations of claim 16. Accordingly, for at least the
18 reasons set forth above with respect to claim 16, the applicant contends that Natori
19 does not anticipate any of claims 17-22, and the applicant therefore respectfully
20 requests that the rejections of each of claims 17-22 under 35 U.S.C. 102
21 be withdrawn.

22 The applicant notes that claim 23 includes the following limitations:

23 providing a stationary track within the scanner body;

24 providing a motive source supported by the light bar assembly; and

25 moving the light bar assembly along the stationary track using the motive source.

 The examiner contends that Natori teaches providing a motive source
supported by the light bar assembly (10 of Fig. 1).

 Natori does not anticipate claim 23 because each and every element as set
forth in claim 23 is not found, either expressly or inherently described, in Natori.
Specifically, Natori does not disclose providing a motive source supported by the
light bar assembly, as is required by claim 23.

1 Instead, as already discussed above, Natori teaches an apparatus having a
2 light bar assembly (10) that is propelled by way of driving means (25), which is
3 supported on the base frame (3). (Natori, col. 4, line 39 through col. 5, line 45.) That
4 is, the motive source, or drive motor, of Natori is not supported by the light bar
5 assembly as is required by claim 23, but instead the motive source of Natori is
6 supported on the stationary base frame (3).

7 Accordingly, for at least the reasons set forth above, the applicant contends
8 that Natori does not anticipate claim 23, and the applicant therefore respectfully
9 requests that the rejection of claim 23 under 35 U.S.C. 102 be withdrawn.

10 The applicant notes that claims 24 and 25 depend from claim 23. Therefore,
11 each of claims 24 and 25 include all of the limitations of claim 23. Accordingly, for at
12 least the reasons set forth above with respect to claim 23, the applicant contends
13 that Natori does not anticipate either of claims 24 and 25, and the applicant therefore
14 respectfully requests that the rejections of each of claims 24 and 25 under
15 35 U.S.C. 102 be withdrawn.

16 The applicant notes that claim 29 includes the following limitations:

17 a light configured to move linearly within the scanner;

18 a motor in fixed association with the light source such that the light source
19 and the motor are moved together.

20 The applicant notes with particularity that the examiner does not even allege
21 in the Office action that Natori discloses "a motor in fixed association with the light
22 source such that the light source and the motor are moved together" as is required
23 by claim 29. The applicant contends that the examiner's rejection of claim 29 is
24 therefore defective because the examiner does not allege that each and every
25 element as set forth in claim 29 is found, either expressly or inherently described,
in Natori.

26 Nevertheless, the applicant contends that even if the examiner had alleged
27 that Natori discloses each and every element set forth in claim 29, as is required for
28 anticipation (which the examiner has not done), Natori does not, in fact, anticipate
29 claim 29 because Natori does not disclose "a motor in fixed association with the light
30 source such that the light source and the motor are moved together" as is required
by claim 29.

Instead, as already discussed above, Natori teaches an apparatus having no more than a light source (10) that is propelled by way of driving means (25), which is supported on the stationary base frame (3). (Natori, col. 4, line 39 through col. 5, line 45.) That is, the motor as taught by Natori is not in fixed association with the light source, but rather, the motor of Natori is supported on the stationary base frame (3) while the light source (10) moves relative to the motor.

Accordingly, for at least the reasons set forth above, the applicant contends that Natori does not anticipate claim 29, and the applicant therefore respectfully requests that the rejection of claim 29 under 35 U.S.C. 102 be withdrawn.

The applicant notes that claims 30-32 depend from claim 29. Therefore, each of claims 30-32 include all of the limitations of claim 29. Accordingly, for at least the reasons set forth above with respect to claim 29, the applicant contends that Natori does not anticipate any of claims 30-32, and the applicant therefore respectfully requests that the rejections of each of claims 30-32 under 35 U.S.C. 102 be withdrawn.

SUMMARY

The applicant believes this response/amendment constitutes a full and complete reply to the office action mailed 02/07/2006. The applicant has also requested reconsideration in regard to the finality of the final action, as set forth herein above. The applicant further believes, for at least the reasons presented herein above, that claims 1-25 and 29-32 are now in allowable form and that the application is now in condition for allowance. Accordingly, the applicants respectfully request timely allowance of claims 1-25 and 29-32.

The examiner is respectfully requested to contact the below-signed attorney if the examiner believes this will facilitate prosecution toward allowance of the claims.

Respectfully submitted,
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Date: March 22, 2006

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Application No. 10/173,326
Docket No. 10013243-1
Response/Amendment